

REMARKS

Claims 1-10, 14-23, and 40-45 remain pending in this application for which applicants seek reconsideration.

Amendment

Independent claims 1, 6, 14, and 19 have been amended to clarify that the insert sheets in each of the bundles are not all the same. Claim 6 also has been amended to remove a typographical error. No new matter has been introduced.

Restriction

Applicants again request clarification regarding the restriction status of claims 11-13 and 24-26 to the extent that the previous Office Action (non-Final) Summary indicated that claims 11-13 and 24-26 have been withdrawn, while the Detailed Action (page 8) rejected these claims on the merits. Although the restriction is moot due to these claims being canceled, nonetheless, it makes a difference whether these claims remain under restriction for continuation/divisional filing purposes. Applicants therefore seek clarification as to whether the examiner withdrew the restriction or not.

Art Rejection

Claims 1-10 and 14-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Inoue (USP 5,159,546) in view of York (USP 4,602,776). Dependent claims 42-45 were rejected under § 103(a) as unpatentable over Inoue in view of York and Austin (USP 5,488,223). Applicants traverse these rejections because they would not have taught at least 1) assigning identification information to insert sheets, 2) insert sheets in the same bundle being not all the same, and 3) reading identification information assigned to insert sheets and detecting a top page in one bundle of insert sheets in carrying out a recovery process from a jam of an insert sheet(s).

As presently claimed, each of the bundles of insert sheets has a plurality of insert sheets that are not all the same. See for example Fig. 7B of the present disclosure. Reading means reads the identification information assigned to the insert sheets. When the insert sheet to be fed first, after a printing instruction has been given or a restart of sheet inserting operation, is not for the top page, the insert sheets are discharged onto an escape tray until the insert sheet for the top page is detected. Independent claims 6 and 19 further call for discharging the

insert sheets immediately preceding the same insert sheet page as a jammed insert sheet during the sheet inserting operation.

Applicants previously argued that there would not have been any motivation for Inoue as combined with York to assign or read identification information, or stack the identical insert sheets in any predetermined order, as the insert sheets are identical in York. In reply, the examiner argues that as the claims do not define anywhere that the insert sheets are not all the same, our argument is not commensurate in scope with the claimed invention. Moreover, the examiner argues that York discloses an example of reading means SE-1, SE-2 for reading the codes written in the insert sheets fed from a single insert sheet tray 60. Applicants disagree with the examiner's assessment for the following reasons.

First, applicants submit that independent claims 1, 6, 14, and 19 sufficiently make it clear that the insert sheets are not all the same. Indeed, these claims explicitly call for detecting based on the output of reading means whether the fed insert sheet is for a top page in one of the bundles of insert sheets. As previously claimed, the insert sheets at least have a top page. Moreover, the claims explicitly state that the insert sheets are fed in a predetermined order of pages in which the insert sheets are to be inserted. This makes it clear that the insert sheets are not all the same; otherwise there would be no need to feed the insert sheets in any predetermined order. Nonetheless, the independent claims now explicitly state that the insert sheets of each bundle are not all the same.

In York, referring to Fig. 3, the insert sheets 62 are divided into groups of insert sheets by one or more dividers (coded sheets) 64. The insert sheets in one group are all the same in contrast to what the claims call for. Inoue merely discloses inserting a sheet of white paper with no coding between overhead head projector (OHP) sheets. See column 41, lines 61-65. The insert sheets are all identical to each other, namely the same white sheets. Accordingly, the combination, even if it were deemed proper for argument's sake, would not have disclosed or taught assigning identification information to insert sheets, let alone insert sheets in the same bundle being not all the same.

Second, York discloses a sensor SE-1 for reading code markings on the coded sheets 64 placed on a recycling document handling apparatus 11 and an insertion material sensor SE-2 for reading code markings on the coded sheets 64 (placed between groups of insert sheets 62 on an insertion feed tray 60) rather than the insert sheets 62. See column 5, lines 9-20 and column 7, lines 26-28. The coded sheets 64 on the insertion feed tray 60 are for dividing the insert sheets 62 and not for inserting between or on the sheets having images formed thereon.

The coded sheets 64 are fed to an overflow tray 72 to be recycled. Note that the insertion material sensor SE-2 only senses the codes on the coded sheets, and not any code on the insert sheets 62. Indeed, referring to Fig. 3, the insert sheet fed from the feed tray 60 first is the top sheet of a grouping of insert sheets 62a. The insertion material sensor SE-2 simply does not sense the insert sheets. Moreover, as the insert sheets in each group are identical, there would not have been any motivation for Inoue to assign or read identification information, let alone stack the insert sheets in any predetermined order. Moreover, as neither York nor Inoue would have taught reading identification information assigned to the insert sheets, even if the combination were deemed proper for argument's sake, the combination would not have taught the claimed invention.

Third, neither York nor Inoue would have disclosed or taught reading identification information assigned to insert sheets and detecting a top page in one bundle of insert sheets in carrying out a recovery process from a jam of an insert sheet(s), as set forth in independent claims 6 and 19.

Conclusion

Applicants submit that claims 1-10, 14-23, and 40-45 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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DATE

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